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09/690,512	10/17/2000	Eric C. Hannah	INTL-0482-US (P10030)	3230

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[REDACTED] ART UNIT

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3622

DATE MAILED: 07/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/690,512	Applicant(s) Eric C. HANNAH et al.
Examiner Stephen M. Gravini	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 6-18-03

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-7, 9, 11-17, 19, and 21-30 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-7, 9, 11-17, 19, and 21-30 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 101

1. Claims 1-7, 9, 11-17, 19, and 27-30 are rejected under 35 U.S.C. 101 because the claimed method does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed invention is an abstract idea which can be performed without interaction of a physical structure. The independently claimed steps of monitoring and accruing does not require structural interaction or mechanical intervention such that the invention falls within the technological arts permitting statutory patent protection. Those steps can be performed by personal skills (i.e. watching and remembering) such that the claimed steps can be performed without a physical structure or mechanical object. Because the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention, it does not produce a useful, concrete and tangible result, is not permitted under 35 USC 101 as being related to non-statutory subject matter. Furthermore each of the claimed steps can be completely performed by a human which further illustrate that the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are statutorily permitted.

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Claim Rejections - 35 USC § 112

2. Claims 1-7, 9, 11-17, 19, and 21-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, the independently claimed method or article including the steps of monitoring, accruing including a processor-based device with a media player and watermark detector, and associating or controlling is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independently claimed invention specifically reciting those steps is considered non-enabling because the specification does not provide a concrete example or illustrating of those claimed steps. The specification discusses this claimed concept but does not enable one skilled in the art how the steps of monitoring and accruing including a processor-based device with a media player and watermark detector is enabled, based on the specification, such that one would know how to make and/or use the invention. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are reasonably conveyed to those skilled in the art.

3. Claims 1-7, 9, 11-17, 19, and 21-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention. The independently claimed method and system including the steps monitoring and accruing including a processor-based device with a media player and watermark detector fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of specifically reciting those features are considered indefinite because the specification does not provide an antecedent basis of those steps. The specification discusses this claimed concept but the claims do not particularly point out and distinctly claim the subject matter which applicant regards as the invention because it is considered that, as discussed in the specification in light of the claims, the claims are indefinite. The independently claimed recitation "said watermark detects watermarks" is considered indefinite because it is unclear how a symbol detects a plurality of itself. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are not indefinite.

Claim Rejections - 35 USC § 102

4. Claims 1-7, 9, 11-17, 19, and 21-30 are rejected under 35 U.S.C. 102(a) as being anticipated by applicants' specification to each of the independently claimed inventions. Since the specification background is customarily used as an introduction to admitted prior art while the claims introduce improvements to the admitted prior art, the independently claimed invention mirrors the specification in subject matter and functionality. In this case the claims contain the

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same subject matter as the specification background and since the background is normally admitted prior art, the claims and claims depending upon them are considered anticipated by the specification admitted prior art. Claims 1-26 are also rejected under 35 U.S.C. 102(b) as being clearly anticipated by Filepp et al. (US 5,347,642), Hannah (US 5,550,595 or US 5,568,192), Fite et al. (US 5,557,721), Graber et al. (US 5,717,860), von Kohorn (US 5,916,024), or Merriman et al. (US 5,948,061), and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by d'Eon et al. (US 6,006,197), Goodman et al. (US 6,173,271), Rhoads (US 6,311,214 or US 6,442,285), or Zhang et al. (US 6,324,420).

Claim Rejections - 35 USC § 103

5. Claims 1-7, 9, 11-17, 19, and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of a method and system of medium storage instructions as provided by television viewing. The claimed advertisement, watermark, and credit are considered non-functional descriptive material which will be discussed infra. The claimed accruing, processor-based device, and media player are considered automation steps to an old and well known manual practice which will be discussed infra. Since at least 1990, examiner has experience with the claimed invention as a television viewer which performs a method and system of medium storage instructions. The claimed method and system comprising:

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monitoring watermark information included with an advertisement information; accruing data after determining that the advertisement was played; and associating an indication that advertisement information was played with an identifier data for a particular user; or monitor a watermark included with an advertisement; accrue data after determining that the advertisement was played; and associate an indication that an advertisement was played with an identifier for a particular user; or an automated processor-based device; an automated media player coupled to said device; a watermark information detector coupled to said automated player, said symbol detects information and controls operation of said player in response to detection of play of information. Examiner also has personal experience with the claimed credit reward, successive accumulation, recorded information at predetermined speeds including intended play time, particular user identifiers, content access, and subsequent replay. The claimed monitoring a play of information or monitor play of information is considered equivalent to examiner viewing information including advertisements on a television monitor. The claimed accruing data after determining that the information was played or accrue data after determining that the information was played is considered equivalent to the examiner television viewer remembering the content of televised information, such as accruing credit to McDonalds if Ronald McDonald data were televised. The

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claimed automated device is considered equivalent to a television remote used to vary television information. The claimed automated player coupled to said device is considered equivalent to the television electronically coupled to the remote. The claimed symbol detector coupled to said automated player, said symbol detects information and controls operation of said player in response to detection of play of information is considered equivalent a televised tone or televised announcement in regular programming that a break will occur in the regular programming for either station identification or advertisement commercials. The claimed credit reward, successive accumulation, recorded information at predetermined speeds including intended play time, particular user identifiers, content access, and subsequent replay are terms common in the field of television viewing. The claimed invention has been performed by the examiner long before the filing of the present invention except for the specifically recited advertisement, watermark, and credit. Those recitations are considered non-functional descriptive language and are not given patentable weight. It would have been obvious to those skilled in the art of a method consumer advertising to use those recitations to seek patent protection. The non-functional descriptive language including the terms advertisement, watermark, and credit are considered merely information, symbols, or data items necessary to provide an accounting for establishing and maintaining an information basis in the field of endeavor claimed by the applicants. This non-functional descriptive language difference is only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The claimed advertisement, watermark, and credit steps would be performed the same regardless of the data. Thus, this descriptive

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material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to claim information, symbols, or data items, particularly advertisement, watermark, and credit, having any type of content, because such data does not functionally relate to the steps in the method and system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Also, the claimed invention contains automated features, such as accruing, processor-based device, and media player, which are obvious variations to the examiner's experience that is so old and well known that the examiner will use Official notice to obviate that claimed subject matter. The claimed invention, recited by the applicant, has been provided examiner personal experience long before the filing of applicant's invention. Examiner notes that it is old and well known to those skilled in the art of a method and system of medium storage instructions, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the automated claimed method and system since those features, particularly accruing, processor-based device, and media player, are merely automated features of a concept that is old and well known. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. The motivation

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to combine applicants claimed invention with the services offered by examiner's experience with television viewing is to allow greater consumer targeting capabilities through electronic mediums, while transferring information, which clearly shows the obviousness of the claimed invention.

Double Patenting

6. Claims 1-7, 9, 11-17, 19, and 21-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/896,772. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application contains the an obvious variation recitation in claim language as applied to the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

7. Applicant's arguments filed June 18, 2003 have been fully considered but they are not persuasive.

non-statutory subject matter

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Applicants argue the amended claims to include the recitation “watermark” overcomes the non-statutory subject matter rejection because that recitation may be designed to be undetectable to users. Claim interpretation under current Office practice does not permit patentability of claims that may be broadly construed. In this case, the examiner broadly construes a watermark to encompass any mark included with an advertisement, under current permitted Office practice of claim interpretation. The possibility that a watermark may be of a certain design does not impart patentability because the claimed watermark may be broadly interpreted to include non-statutory subject matter discussed above in the rejection.

enablement and indefiniteness

The argument that a skilled artisan would know how to use the claimed invention without undue experimentation is merely an assertion of patentability without convincing the Office of patentability.

anticipation

Applicants argue the claimed watermark or identifier distinguishes the invention over the anticipatory prior art but under current Office practice a watermark may be any indicia that can identify an advertisement. A watermark, identifier, or any advertisement indicia clearly anticipates the claimed invention by any one of the prior art references.

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obviousness

An examiner declaration has been provided per applicants' request such that a prior art reference is not necessary.

double patenting

Applicants assert the co-pending application is unrelated, but the differences in the co-pending application and the present application are merely non-functional descriptive material. Both applications perform substantially the same function using the substantially the same means or steps with substantially the same result.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9326
Non-Official/Draft	(703) 872-9325

Steve Gravini
STEPHEN GRAVINI
PRIMARY EXAMINER

smg

July 21, 2003

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EXAMINER AFFIDAVIT SUPPORTING OBVIOUSNESS REJECTION

Claims 1-7, 9, 11-17, 19, and 21-30 are an obvious variation of examiner's personal experience of a method and system of medium storage instructions as provided by television viewing. The claimed advertisement, watermark, and credit are considered non-functional descriptive material which will be discussed infra. The claimed accruing, processor-based device, and media player are considered automation steps to an old and well known manual practice which will be discussed infra. Since at least 1990, examiner has experience with the claimed invention as a television viewer which performs a method and system of medium storage instructions. The claimed method and system comprising:

monitoring watermark information included with an advertisement information;
accruing data after determining that the advertisement was played; and
associating an indication that advertisement information was played with an identifier data for a particular user; or
monitor a watermark included with an advertisement;
accrue data after determining that the advertisement was played; and
associate an indication that an advertisement was played with an identifier for a particular user; or
an automated processor-based device;
an automated media player coupled to said device;

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a watermark information detector coupled to said automated player, said symbol detects information and controls operation of said player in response to detection of play of information. Examiner also has personal experience with the claimed credit reward, successive accumulation, recorded information at predetermined speeds including intended play time, particular user identifiers, content access, and subsequent replay. The claimed monitoring a play of information or monitor play of information is considered equivalent to examiner viewing information including advertisements on a television monitor. The claimed accruing data after determining that the information was played or accrue data after determining that the information was played is considered equivalent to the examiner television viewer remembering the content of televised information, such as accruing credit to McDonalds if Ronald McDonald data were televised. The claimed automated device is considered equivalent to a television remote used to vary television information. The claimed automated player coupled to said device is considered equivalent to the television electronically coupled to the remote. The claimed symbol detector coupled to said automated player, said symbol detects information and controls operation of said player in response to detection of play of information is considered equivalent a televised tone or televised announcement in regular programming that a break will occur in the regular programming for either station identification or advertisement commercials. The claimed credit reward, successive accumulation, recorded information at predetermined speeds including intended play time, particular user identifiers, content access, and subsequent replay are terms common in the field of television viewing. The claimed invention has been performed by the examiner long before the

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filing of the present invention except for the specifically recited advertisement, watermark, and credit. Those recitations are considered non-functional descriptive language and are not given patentable weight. It would have been obvious to those skilled in the art of a method consumer advertising to use those recitations to seek patent protection. The non-functional descriptive language including the terms advertisement, watermark, and credit are considered merely information, symbols, or data items necessary to provide an accounting for establishing and maintaining an information basis in the field of endeavor claimed by the applicants. This non-functional descriptive language difference is only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The claimed advertisement, watermark, and credit steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to claim information, symbols, or data items, particularly advertisement, watermark, and credit, having any type of content, because such data does not functionally relate to the steps in the method and system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Also, the claimed invention contains automated features, such as accruing, processor-based device, and media player, which are obvious variations to the examiner's experience that is so old and well known that the examiner will use Official notice to obviate that claimed subject matter. The claimed invention, recited by the applicant, has been provided examiner personal experience long before the filing of

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applicant's invention. Examiner notes that it is old and well known to those skilled in the art of a method and system of medium storage instructions, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the automated claimed method and system since those features, particularly accruing, processor-based device, and media player, are merely automated features of a concept that is old and well known. The motivation to combine applicants claimed invention with the services offered by examiner's experience with television viewing is to allow greater consumer targeting capabilities through electronic mediums, while transferring information, which clearly shows the obviousness of the claimed invention.

I hereby declare that all statements made under this declaration of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under 18 USC 1001 and that such will false statements may jeopardize the validity of the application or any patent issued thereon.

See Thorne